

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRYAN JEFFERY MOLES

Appeal 2006-2594
Application 10/034,394
Technology Center 2100

Decided: February 22, 2007

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and MAHSHID D. SAADAT, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-21. The Appellant appeals therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

A. INVENTION

The invention at issue on appeal transforms markup language documents for display on wireless communications devices. (Specification 1.) Wireless communications devices such as mobile telephones and personal digital assistants ("PDAs") provide access Internet World Wide Web sites and enterprise intranet servers. Data retrieved therefrom include documents created in a markup language such as a HyperText Markup Language ("HTML") or Extensible Markup Language ("XML"). (*Id.* 1-2.)

Markup language documents from Internet-type servers are generally created and formatted for display on systems having large display areas, e.g., personal computers or workstations. Wireless communications devices, in contrast, usually feature small display areas incapable of displaying markup language documents in the form in which they were intended to be displayed. Graphic images, tables, and forms are particularly problematic to display on wireless communications device. (*Id.* 2.)

Accordingly, the Appellant's conversion controller scans part of a markup language document for tags associated with graphical images. The controller replaces each detected image with one of a set of placeholders, each having a label corresponding to a button. Actuation of the button initiates display of the replaced image. The controller reuses placeholders to replace graphical image within other parts of the markup language source when the other parts are displayed. (*Id.* 4.)

Claims 1 and 8, which are further illustrative of the invention, follow:

1. For use in a browser, a converter for adapting markup language documents for display in small areas comprising:

a conversion controller scanning a portion of markup language source selected for display for tags associated with graphical elements and automatically replacing each detected graphical element within the selected markup language source portion with one of a plurality of placeholders having labels corresponding to a set of buttons,

wherein the plurality of placeholders are reused to replace detected graphical elements within other portions of the markup language source when such other portions are selected for display.

8. A communications device comprising:

a display;

an input for receiving a markup language document to be displayed on the display; and

a conversion controller scanning a selected display portion of source for the markup language document for tags associated with graphical elements and automatically replacing each detected graphical element within the selected markup language source portion with one of a plurality of placeholders having labels corresponding to a set of buttons,

wherein the plurality of placeholders are reused to replace detected graphical elements within other portions of the markup language source when such other portions are selected for display.

B. REJECTION

Claims 1-21 stand rejected under 35 U.S.C. § 103(a) as obvious over *Web Page Filtering and Re-Authoring for Mobile Users*, The Computer Journal, Vol. 42, No. 6, pp. 534-546, April 21, 1999 ("Bickmore") and U.S. 6,489,976 B1 ("Patil").

II. CLAIM GROUPING

"When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately." 37 C.F.R. § 41.37(c)(1)(vii) (2005).¹ "A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim." *Id.*

Here, the Appellant argues claims 1 and 15, which are subject to the same ground of rejection, as a group. (Br. 17.) Furthermore, he merely points out what claims 2-7 and 16-21 recite and alleges that such limitations are not taught by the references. (*Id.* 10-13, 20.) Because these allegations

¹ We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief.

do not challenge the rejection of the individual claims "with any reasonable specificity," *In re Nielsen*, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987), these do not constitute arguments for the separate patentability of these claims.² Therefore, we select claim 1 as the sole claim on which to decide the appeal of claims 1-7 and 15-21.

Similar to claims 2-7 and 16-21, the Appellant merely points out what claims 9-14 recite and alleges that such limitations are not taught by the references. Because these allegations do not challenge the rejection of the individual claims "with any reasonable specificity," *id.*, these allegations do not constitute arguments for the separate patentability of these claims.³ Therefore, we select claim 8 as the sole claim on which to decide the appeal of claims 8-14. With these representations in mind, rather than reiterate the positions of the Examiner or the Appellant *in toto*, we focus on the following issues therebetween:

- motivation to combine Bickmore and Patil
- placeholders having labels corresponding to buttons
- controller for scanning and replacing.

III. MOTIVATION TO COMBINE BICKMORE AND PATEL

The Examiner finds that column 1, lines 55-62, of Patil would have "cause[d] one of ordinary skill in the art to provide an alternate method of choosing an onscreen object, which Patil does by using shortcut keys that correspond the onscreen objects." (Answer 7.) The Appellant alleges "that

² Assuming *arguendo* that they did constitute separate arguments, they fail to show any error in the Examiner's rejections.

³ Assuming *arguendo* that they did constitute separate arguments, they fail to show any error in the Examiner's rejections.

there is no suggestion or motivation in either Bickmore or Patil to cause one of *ordinary* skill in the art to undertake such a highly speculative and selective process." (Br. 10.) Therefore, the issue is whether a motivation to combine Bickmore and Patil exists.

"The presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact." *In re Gartside*, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000) (citing *In re Dembiczaik*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)). A suggestion to combine teachings from the prior art "may be found in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." *WMS Gaming Inc. v. Int'l Game Tech.*, 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999) (citing *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998)).

Here, like the Appellant's invention, Bickmore's "Digestor system automatically converts web-based documents designed for desktop viewing into formats appropriate for handheld devices with small display screens, such as Palm-PCs, PDAs and cellular phones." (Abstract, ll. 1-3.) "The approach taken in Digestor is to provide a set of techniques that transform all images in a page by pre-defined scaling factors (25%, 50% and 75%) and making the reduced images hypertext links back to the originals." (P. 539.)

For its part, Patil "relates to a system and method for displaying pop-up symbols to enable users to select accelerator keys associated with

computer software options." (Col. 1, ll. 15-17.) More specifically, the secondary reference "display[s] pop-up accelerator key symbols associated with and next to option icons and that represent keys that may be selectable by the user through use of a keyboard or other input devices to implement the option with which the symbol is associated." (Col. 2, ll. 27-37.)

Patil explains that accelerator keys offer the advantages of "speed[ing] the selection of certain options," (*id.* ll. 32-33), and "avoid[ing] the need for users to remove their hands from a keyboard." (*Id.* ll. 60-61.) The secondary reference further explains the advantage of its pop-up symbols. To wit, the symbols improve accelerator keys by "enabl[ing] a user to select options by using accelerator keys without requiring memorization or requiring the user to manually check a reference guide." (Col. 2, ll. 34-36.) We agree with the examiner's finding that these advantages would have provided a motivation to combine Bickmore and Patil.

IV. PLACEHOLDERS HAVING LABELS CORRESPONDING TO BUTTONS

The Examiner finds, "Patil is meant to teach labels that correspond to buttons, not placeholders. Bickmore is relied upon to teach placeholders. . . ." (Answer 6.) The Appellant argues, "At best, Patil's secondary pop-up symbols are supplemental display elements - appearing together with, not in place of, the graphical element (*e.g.*, icon) with which they are associated. They provide a user with an indication of a multi-key keystroke that may be utilized as an alternative actuating the graphical element itself (*e.g.*, 'clicking' the icon)." (Br. 9.) Therefore, the issue is whether the

combination of references would have suggested replacing each graphical image with a placeholder having a label corresponding to a button.

In addressing the issue, the Board conducts a two-step analysis. First, we construe the representative claim at issue to determine its scope. Second, we determine whether the construed claim would have been obvious.

A. CLAIM CONSTRUCTION

"Analysis begins with a key legal question — what is the invention claimed?" *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987). In answering the question, "the PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1668 (Fed. Cir. 2000)). "Moreover, limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Here, claim 1 recites in pertinent part the following limitations: "replacing each detected graphical element within the selected markup language source portion with one of a plurality of placeholders having labels corresponding to a set of buttons. . ." Giving the representative claim the broadest, reasonable construction, the limitations require replacing each graphical image with a placeholder having a label corresponding to a button.

B. OBVIOUSNESS DETERMINATION

"Having determined what subject matter is being claimed, the next inquiry is whether the subject matter would have been obvious." *Ex Parte Massingill*, No. 2003-0506, 2004 WL 1646421, at *3 (B.P.A.I 2004). "Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references." *In re Merck & Co.*, 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)). In determining obviousness, furthermore, a reference "must be read, not in isolation, but for what it fairly teaches in combination with the prior art as a whole." *Id.*, *Id.*

Here, the rejection is based on the combined teachings of Bickmore and Patil. Because the primary reference "transform[s] all images in a page by pre-defined scaling factors . . . and mak[es] the reduced images hypertext links back to the originals," (p. 539), we find that Bickmore replaces each graphical image with a placeholder. In fact, the Appellant admits that "such 'thumbnail' in-page hyperlinks may indeed be placeholders. . ." (Br. 7.)

As aforementioned, Patil disclose that its combination of accelerator keys and pop-up symbols speeds the selection of options without requiring removal of hands from a keyboard, memorization, or manually checking a reference guide. We further find that such advantages would have provided a motivation to employ accelerator keys and pop-up accelerator key symbols with the thumbnail in-page hyperlinks. When the teachings were so combined, we find that the combination would have suggested replacing

each graphical image with a placeholder having a label corresponding to a button. Therefore, we affirm the rejection of claim 1 and of claims 2-7 and 15-21, which fall therewith.

V. CONTROLLER FOR SCANNING AND REPLACING

The examiner makes the following finding.

Bickmore discloses a converter for automatically adapting markup language documents for display in small areas comprising: a conversion controller scanning a portion of markup language source selected for display for tags associated with graphical elements and replacing each detected graphical element (Column 4 lines 60-63, Column 5 lines 1-2) within the selected markup language source portion with one of a plurality of placeholders (Column 11 lines 23-26).

(Answer 3.) Observing that "[t]his element requires a controller that both scans a portion of source for tags and automatically replaces each detected graphical element with one of the plurality of placeholders," (Br. 14), the Appellant alleges, "Nothing in Bickmore or Patil, or any combination of them, appears to teach this element as described with relation to all other elements of this claim." (*Id.*) Therefore, the issue is whether the combination of references would have suggested a controller that scans a document for tags associated with graphical images and replaces each graphical image with a placeholder having a label corresponding to a button.

A. CLAIM CONSTRUCTION

Claim 8 recites in pertinent part the following limitations:
"a conversion controller scanning a selected display portion of source [sic]
for the markup language document for tags associated with graphical

elements and automatically replacing each detected graphical element within the selected markup language source portion with one of a plurality of placeholders having labels corresponding to a set of buttons. . . ." Giving the representative claims the broadest, reasonable construction, the limitations require a controller that scans a document for tags associated with graphical images and replaces each graphical image with a placeholder having a label corresponding to a button.

B. OBVIOUSNESS DETERMINATION

The question of obviousness is "based on underlying factual determinations including . . . what th[e] prior art teaches explicitly and inherently. . . ." *In re Zurko*, 258 F.3d 1379, 1383, 59 USPQ2d 1693, 1696 (Fed. Cir. 2001) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966); *In re Dembicza*k, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999); *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, as mentioned regarding the prior issue, we have found that the combination of Bickmore and Patil would have suggested replacing each graphical image with a placeholder having a label corresponding to a button.

Bickmore also discloses that its "Digestor performs a depth-first search of the document transformation space, using many heuristics that describe preconditions for transformations and combinations of transformations."

(P. 539.) "Each state in the transformation space represents a version of the document, with the initial state representing the original 'as-authored' document (see Figure 6)." (*Id.*) We also find that the Digestor constitutes a controller and that its searching constitutes scanning a document for tags associated with graphical images. Therefore, we affirm the rejection of claim 8 and of claims 9-14, which fall therewith.

VI. CONCLUSION

In summary, the rejection of claims 1-21 under § 103(a) is affirmed.

"Any arguments or authorities not included in the brief or a reply brief filed pursuant to [37 C.F.R.] § 41.41 will be refused consideration by the Board, unless good cause is shown." 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, our affirmation is based only on the arguments made in the brief. Any arguments or authorities omitted therefrom are neither before us nor at issue but are considered waived. *Cf. In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004) ("[I]t is important that the applicant challenging a decision not be permitted to raise arguments on appeal that were not presented to the Board.") No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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AFFIRMED

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